

Fischer
(K) 54 084

Remarks

Claims 21-43 are currently pending in this application. Claims 21-30, 42 and 43 are allowed.

Claim Rejections Under 35 USC 102 and 35 USC 103(a)

Claims 31-41 are rejected under 35 USC 102. On page 2, paragraph 3, the Office Action states that claims 31-33 and 35-37 are rejected under 35 USC 102(b) as being clearly anticipated by Fischer '286.

On page 2, paragraph 5, the Office Action goes on to state that, under 35 USC 103(a), claims 36 and 38-41 are rejected under 35 USC 103(a) as being unpatentable over Fischer '286. In paragraph 6, the Office Action states "Fischer discloses all of the claimed subject matter, except for the casting composition and the specific structural details of the protective sleeve. The Office Action states that these features are considered obvious design considerations well within the capabilities of one skilled in the art."

We respectfully disagree with the Office Action.

Valid rejection under 35 USC 102 requires that each feature of a rejected claim be disclosed in a single reference. "For anticipation under 35 USC 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present." MPEP 706.02(a)

Fischer '286 (column 4, line 42 to column 5, line 11) describes a special embodiment for providing a probe using the Eddy-Current principal measurement. This probe comprises a sleeve 28 around the core 13 and further, a shielding sleeve 43 around

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the outer sleeve 28. Between each sleeve is provided a gap for positioning the coil 16 and 36.

The present application provides a cup-type core with one gap for receiving the first coil device whereby the second coil device is provided concentrically outside to the cup-type core. This embodiment is not disclosed in Fischer '286, Figure 1 and in the referred to description on column 4, line 42 to column 5, line 11 of Fischer '286. Therefore, this feature of the present application is new, and Fischer '286 does not disclose all of the features of the claimed subject matter of the present application.

Further, the features according to the present application as claimed in claim 31 are also not anticipated by Fischer '286 with respect to column 5, lines 12 to 15 and column 6, lines 22 to 28. This embodiment of the prior art describes a cup-type core wherein the annular gaps 48 and 49 are provided in one piece in a cup-type core. That means that both gaps are provided in the cup-type core in Fischer '286. In contrast, the present application comprises only one gap for receiving a first coil. The second coil is provided outside of the cup-type core and not in the cup-type core, as disclosed in Fischer '286 column 5, lines 22 and 23. Therefore, the embodiment of the present invention is not anticipated by Fischer '286.

In addition, it is also not obvious to provide a probe according to the invention as claimed in claim 31.

The probe of Fischer '286 comprises a core 13, an outer sleeve 28 and a shielding sleeve 23 and provides in-between gaps 48 and 49. The core 13, outer sleeve 28 and shielding sleeve 3 are of magnetizable high permeable material and fitted together according to Fig. 1. An exact positioning of the parts is requested when they are to be

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fixed together. Instead of using three different components 13, 28 and 43, Fischer '286, column 5, lines 12 to 16 and lines 22 to 28 provides those gaps 48 and 49 in one piece in a cup-type core. This is a different embodiment with respect to the embodiment shown in Fig. 1 of Fischer '286.

In contrast, the present application describes a cup-type core comprising one gap to receive a first core and receiving a second core outside of the cup-type core. This embodiment is embedded in a casting composition protected by a housing.

Therefore, the present application has left the principal of construction according to Fischer '286 to achieve an improved embodiment. Nearly ten years has passed since Fischer '286 until the embodiment according to the present invention as claimed in claim 31 was achieved. Due to the embodiment of the present application, a very easy positioning of the coils was enabled, resulting in decreased manufacturing costs. Further, the embodiment of the present invention enables good results for the sequentially non-descriptive thickness measurement.

In Figure 2, a cup-type core is clarified. This new Figure 2a clearly shows the features according to claim 31, wherein a first coil is in the cup-type core and the second core is positioned outside. This new Figure 2a also corresponds to the top view according to Figure 3.

Enclosed is a Letter to the Draftsperson of the Patent Office requesting the Examiner's approval of the new Figure 2a, as discussed above.

While Applicant respectfully believes that the above arguments present a strong case, on their own merit, as to why the present invention is patentable over Fischer '286, there is yet another argument that is relevant. According to MPEP 706.02(k), effective

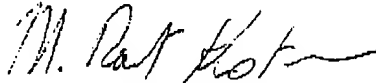
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November 29, 1999, subject matter that was prior art is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation or Assignment to the same person." Fischer '286 and the present invention were owned by the same person or subject to an obligation or Assignment to the same person. The present application was filed after November 29, 1999. Consequently, it is not appropriate to cite Fischer '286 against the present invention as prior art, given MPEP 706.02(k). For this reason, since no other art is cited against the present invention, the present invention should be patentable.

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A two-month extension of time in which to respond to the outstanding Office Action is hereby requested. PTO Form 2038 is enclosed to cover the prescribed Small Entity two-month extension fee of \$200. Please charge any additional fees or credit any overpayments to Deposit Account 11-0665. A duplicate of this page is enclosed for this purpose.

Respectfully submitted,



M. Robert Kestenbaum
Reg. No. 20,430
11011 Bermuda Dunes NE
Albuquerque, NM USA 87111
Telephone (505) 323-0771
Facsimile (505) 323-0865

I hereby certify this correspondence is being submitted to Commissioner for Patents, Washington, D.C. 20231 by facsimile transmission on October 27, 2002, fax number (703) 305-3988.



M. Robert Kestenbaum